

REMARKS

Claims 1 through 40 are pending. Claims 1 through 21 are allowed. Claims 22–28 stand rejected. Applicant gratefully acknowledges the allowance of claims 1–21 and respectfully requests reconsideration of claims 22–28, consideration of new claims 29–40, and allowance of all claims of this application.

Claim 18 has been amended to correct the spelling of “monostable” and not for reasons related to patentability. Claims 22 and 23 have been amended for consistency with claims 1–21 regarding the term “level” and not for any reasons related to patentability. Claim 24 has been amended to remove the requirement that the timer be a monostable timer and not for any reasons related to patentability. Claims 29–37 are added to alternately claim the invention and are consistent with the reasons for allowance provided in the Office Action. Claims 38–40 are added to alternately claim the use of a timer and are dependent on allowed base claims. Claims 38–40 are the same as allowed claims 8, 9, and 18, except they have had the requirement that the timer be a monostable timer removed, which was done for clarity and not for any reasons related to patentability.

Claims 22, 23 and 25–28 stand rejected under 35 U.S.C. § 103(a) as assertedly unpatentable over U.S. Pat. No. 5,094,235 to Westenskow et al., in view of U.S. Pat. No. 5,044,362 to Younes and further in view of U.S. Pat. No. 5,193,544 to Jaffe. The Office Action asserts that Westenskow et al. ‘235 teaches the claimed invention, but is silent regarding the ventilator comprising a blower or the carbon dioxide sensor comprising an infrared light emitter and detector in circuit communication with the controller.

The system in Westenskow ‘235 does not use the measurement of carbon dioxide to maintain open the airway of a patient, as claimed in claim 22 of the present application. In contrast to claim 22, the system in Westenskow ‘235 uses carbon dioxide concentration as but one part of the control of the concentrations of the components of anesthesia gas being provided to the patient. Applicant respectfully submits that the

references cited in the Office Action were improperly combined and were improperly applied to independent claim 22.

The Combination Of References Is Improper

Each prior art reference and the claimed invention must be evaluated as a whole in determining obviousness. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143 (Fed. Cir. 1985). It is not permitted to first determine what it was the inventor did and then select only those facts from the prior art which may be modified to construct the invention from the prior art. *In re Shuman*, 361 F.2d 1008 (CCPA 1966). One “cannot pick and choose among the individual elements of assorted prior art references to recreate the claimed invention.” *SmithKline Diagnostics, Inc. v. Helena Laboratories Corp.*, 859 F.2d 878, 887 (Fed. Cir. 1988). It is not proper that prior art references be cobbled together and “employed as a mosaic to recreate a facsimile of claimed invention.” *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1552 (Fed. Cir. 1983).

In the present case, applicant respectfully submits that the combination suggested by the Office Action is improper, as is evident when the claimed invention and the prior art are considered as a whole. The primary reference, Westenskow et al. ‘235, is directed to “an anesthesia ventilating apparatus having a breathing circuit wherein the anesthesia gases necessary for the ventilation can be metered and influenced via a control loop.” Column 1, lines 8–11. “The anesthetic ventilating apparatus of the invention is for administering anesthesia to a patient.” Column 9, lines 47–48.

One of the control loops described in Westenskow et al. ‘235 measures terminal expiration carbon dioxide concentration. Column 8, lines 15–43. The carbon dioxide concentration is controlled by changing the ventilating frequency. *See, e.g.*, column 5, lines 63–65; column 8, lines 15–43. Although the Office Action asserts that “changing the frequency of ventilation changes the pressure of the breathing gas provided to the patient,” there is no support provided for this statement. In fact, changing the frequency

of ventilation does not always change the pressure of breathing gas, as further discussed below.

Westenskow et al. '235 specifically calls out a piston-cylinder arrangement as the type of ventilator suitable for use for delivery of anesthesia in accordance with that invention. Column 5, lines 6–7. Westenskow et al. '235 defines ventilating frequency as “number of strokes [of the piston] per minute.” Column 8, lines 29–31. The Office Action asserts that Younes '362 “teaches that it is known in the art to provide positive pressure breathable gas to a patient via ventilators comprising blowers” and that “it would be obvious to use a ventilator comprising a blower since it is well known in the art to use blowers to provide positive pressure to a patient.” The Office Action fails to consider that the change in ventilation frequency defined and taught by Westenskow et al. '235 may not be possible using a blower for a ventilator.

The Office Action has not identified any art that indicates or hints that the frequency of ventilation defined by Westenskow et al. '235 may be automatically controlled based on carbon dioxide concentration and using a blower. Because it is uncertain whether a blower would even work as a ventilator in the Westenskow et al. '235 device, and Westenskow et al. '235 specifically calls out a different device, it would not be obvious to “use a ventilator comprising a blower” as asserted in the Office Action. Nor is there is any motivation cited by the Office Action to make such an uncertain combination. Thus, when the prior art references are considered as a whole for what they teach, the combination of the blower of Younes '362 with the anesthesia delivery device of Westenskow '235 is improper.

The claims of the present application stand rejected based upon a cobbling together of various individual elements of prior art references. “It is impermissible within the framework of Section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.” *In re Wesslau*, 353 F.2d 238, 241(CCPA 1965); *see also Bausch & Lomb, Inc. v. Barnes-*

Hind/Hydrocurve, Inc., 796 F.2d 443, 448-49 (Fed. Cir. 1986). The prior art references must be considered as a whole, not just for the individual elements thereof. “[T]he inquiry is not whether each element existed in the prior art, but whether the prior art made obvious the invention as a whole for which patentability is claimed.” *Hartness Int’l, Inc. v. Simplimatic Eng. Co.*, 819 F.2d 1100, 1108 (Fed. Cir. 1987).

When Considered as a Whole, the References Are Improperly Applied Against the Claims

Moreover, Westenskow et al. ‘235 is improperly applied against claim 22 of the present application when both are considered as a whole, as they must be. In Westenskow et al. ‘235, the anesthetic gas delivery device controls the concentrations of the various anesthetic agents. *See, e.g.*, column 3, lines 10–53; column 4, lines 35–49. In contrast, claim 22 of the present application claims logic for increasing and decreasing the pressure of positive pressure breathing gas to maintain open the airway of a patient, not to control the concentrations of the components of the gas supplied to the patient. The pressure of the positive pressure breathing gas is increased or decreased based on the level of carbon dioxide detected.

As identified above, the Office Action improperly asserts that changing the frequency of ventilation to control the carbon dioxide concentration necessarily changes the pressure of the positive pressure breathing gas. This is not necessarily the case and there is no support provided for the assertion. Other parameters, such as anesthetic gas flow into the system and breathing stroke volume of the ventilator, influence the pressure of the breathing gas. *See, e.g.*, Column 9, lines 15–22. For example, an increase of ventilation frequency could either increase or decrease the pressure of the breathing gas, if the anesthetic gas flow and/or breathing stroke volume are changed. So the change of ventilation frequency in Westenskow et al. ‘235 is improperly applied against the change in pressure of the positive pressure breathing gas claimed in claim 22 of the present application.

The Office Action further asserts that the control loop described at column 8, lines 15–43 of Westenskow et al. '235 corresponds with the claimed “logic for increasing and decreasing the pressure of the positive pressure breathing gas based on the concentration of carbon dioxide detected to maintain open the airway of a patient.” On the contrary, Westenskow et al. '235 does not use the concentration of carbon dioxide to maintain open the airway of the patient, as claimed in claim 22. The concentration of carbon dioxide in Westenskow et al. '235 is one part of the control of the concentrations of the components of the anesthesia gas being provided to the patient and not designed to maintain open the airway of a patient. *See, e.g.*, column 2, lines 18-25; column 4, lines 35–49. Thus, Westenskow et al. '235 is improperly applied against claim 22 of the present application.

For at least these reasons, the rejection of claim 22 under 35 U.S.C. § 103(a) is improper, and Applicant respectfully requests that the rejection of claim 22 be withdrawn.

Claims 23 and 25–28 are dependent from claim 22 and are allowable as being dependent from an allowable base claim, as well as being independently allowable.

Claim 24 stands rejected under 35 U.S.C. § 103(a) as assertedly unpatentable over Westenskow et al. '235 in view of Younes '362 and Jaffe '544 and further in view of U.S. Pat. No. 3,921,628 to Smythe et al. Claim 24 is a dependent claim that depends from independent claim 22, discussed above. Because this dependent claim depends from an allowable independent claim, it is respectfully submitted that the dependent claim is also allowable, as well as being independently allowable.

Comments on Statement of Reasons for Allowance

Applicant gratefully acknowledges the reasons for allowance provided in the Office Action. Applicant notes that the reasons for allowance are general and not intended to import limitations into any of the claims.

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CONCLUSION

Claims 1–40 are pending. Applicant gratefully acknowledges the allowance of claims 1–21. For at least the above reasons, Applicant respectfully submits that the rejections in the Office Action of claims 22–28 are improper. Claims 29–40 are added herewith. Applicant believes that all of the claims in this case are in condition for allowance and respectfully solicits an indication to that effect. If the Examiner believes that additional discussions or information might advance the prosecution of this case, the Examiner should feel free to contact the undersigned at the telephone number indicated below.

Respectfully submitted,

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